IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Masatsugu Maeda et al.	Art Unit	: 1633
Patent No.	: 7,482,440	Examiner	: Anne Marie Sabrina Wehbe
Issue Date	: January 27, 2009	Conf. No.	: 5055
Serial No.	: 10/006,265		
Filed	: December 3, 2001		
Title	: NOVEL HEMOPOIETIC RECEPTOR PROTEIN, NR10		

Commissioner for Patents
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Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 362 to 907 days, is respectfully requested.

REMARKS

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth v. Dudas, 580 F. Supp. 2d 138 (D.D.C. 2008), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years."

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"B delay" begins only after the PTO has failed to issue a patent within three years, not before.
<u>Id.</u>

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

"A Delay"

A first PTO action was due on or before February 3, 2003 (the date that is fourteen
months after December 3, 2001, the date on which the application was filed). The PTO mailed
the first non-final Office Action on December 13, 2004, thereby according a PTO Delay of
<u>679 days</u>. Patentee does not dispute the PTO's calculation for this "A Delay" from
February 4, 2003 (the day after the date that is fourteen months after the date on which the
application was filed), to December 13, 2004. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

Patent issuance was due on or before November 10, 2008 (the date that is four months
after July 10, 2008, the date on which the issue fee was paid). The PTO issued the patent on
January 27, 2009, and accorded a PTO Delay of 76 days. One entry in the PAIR system
correctly indicates "Issue Fee Payment Verified" on July 10, 2008, the date on which the issue
fee payment was made. A second entry in the PAIR system incorrectly identifies "Issue Fee
Payment Verified" on July 12, 2008. Patentee respectfully submits that the PTO's calculation of
PTO Delay contains an error and requests that the Office recalculate the PTO Delay for this
"A Delay" as <u>78 days</u>, from July 11, 2008 (the day after the date that is four months after the date
on which the issue fee was paid), to January 27, 2009 (the day on which the patent issued).
See 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6).

In view of the periods of "A Delay" detailed above, the total "A Delay" for this patent
should be calculated as <u>757 days</u> (i.e., the sum of 679 days and 78 days).

"B Delay"

The period beginning on December 4, 2004 (the day after the date that is three years after
the date on which the application was filed), and ending January 27, 2009 (the date the patent
was issued), is 1,516 days in length.

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"B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on June 21, 2006, and the patent issued on January 27, 2009, resulting in a period of 951 days that must also be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

"B Delay" for this patent is therefore calculated as 1,516 days minus 951 days, for a total of 565 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 565 days.

Overlap of "A Delay" and "B Delay"

The "A Delay" and the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 10 days, from December 4, 2004, to December 13, 2004.

Applicant Delay

Patentee filed an Information Disclosure Statement on January 31, 2005, subsequent to a reply filed on January 10, 2005. Patentee was accorded a delay of 21 days for a supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from January 11, 2005, to January 31, 2005. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before June 14, 2005 (the date that is three months after March 14, 2005, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on September 14, 2005, thereby according an Applicant Delay of 92 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from

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June 15, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to September 14, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before March 21, 2006 (the date that is three months after December 21, 2005, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on June 21, 2006, thereby according an Applicant Delay of 92 days, as outlined in the Letter Regarding PTA mailed by the Office of Petitions on December 23, 2008, in response to Applicant's Letter regarding PTA filed July 10, 2008. Patentee does not dispute the PTO's calculation for this Applicant Delay from March 22, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to June 21, 2006. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on July 14, 2006, subsequent to a reply filed on June 21, 2006. Patentee was accorded a delay of 23 days for a supplemental response, as outlined in the Office's Letter Regarding PTA mailed by the Office of Petitions on December 23, 2008. Patentee does not dispute the PTO's calculation for this Applicant Delay from June 22, 2006 to July 14, 2006. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before October 26, 2006 (the date that is three months after July 26, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on January 5, 2007, thereby according an Applicant Delay of 71 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from October 27, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to January 5, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before June 22, 2007 (the date that is three months after March 22, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on September 24, 2007, thereby according an Applicant Delay of 94 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from June 23, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to September 24, 2007. See 37 C.F.R. § 1.704(b).

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Patentee filed an Information Disclosure Statement on July 10, 2008, subsequent to a Notice of Allowance mailed by the PTO on April 11, 2008. Patentee was not accorded a delay for a supplemental response. In good faith and candor, Patentee notes that the supplemental Information Disclosure Statement should have been accorded a total Applicant Delay of <u>12 days</u>, for delay beginning on July 10, 2008 (the day on which the Information Disclosure Statement was filed) and ending on July 21, 2008 (the day on which the PTO mailed its response). See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as <u>405 days</u> (i.e., the sum of 21 days, 92 days, 92 days, 23 days, 71 days, 94 days, and 12 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 362 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

1)   Total PTO Delay should be calculated as 1312 days (i.e., the sum of 757 days of "A Delay" and 565 days of "B Delay" minus the 10 days of overlap);

2)   Total Applicant Delay should be calculated as 405 days; and

3)   <u>Total PTA should be calculated as 907 days</u>.

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The fee of $200 required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 14875-0096001.

Respectfully submitted,

Date: <u>March 27, 2009</u>

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